



PATENT
ATTY. DOCKET NO. L-F/104H

AF 3763
#19
8C
1/29/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Niehoff
Serial No. : 09/307,633
Filed : May 7, 1999
For : SYRINGE WITH INDICIA FOR CONTROLLING PLUNGER DRIVE
(AS AMENDED)

Art Unit: 3763
Examiner: J. Maynard

Assistant Commissioner of Patents
Washington, DC 20231

REQUEST FOR REHEARING UNDER 37 C.F.R. §1.197(b)

Applicant respectfully requests rehearing and reconsideration of the Decision of the Board mailed October 17, 2002.

Applicant submits that the decision of the Board raises a new issue with respect to claims 26-31. The Board's decision asserts, with respect to the '858 patent of Reilly, a "belief that the rib 74 proximate to the plunger in a pre-filled syringe is related to the amount of fluid in the pre-filled syringe" (Decision, pages 11-12), and an "opinion that the rib 74 proximate to the location of the plunger in a syringe is both related to the end of travel position of an injector ram coupled

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NO OF PATENT APPEALS
IN REHEARING

to the plunger when the syringe is coupled to an injector and to the range of travel of an injector ram coupled to the plunger when the syringe is coupled to an injector" (Decision, page 12).¹

The Examiner's Answer included no assertion that one of the ribs 74 shown in Fig. 5 of the '858 patent would be "proximate to the plunger" when a pre-filled or empty syringe is mounted to an injector, and had no assertion that there would be a rib in a location that could be correlated in any way to the amount of fluid in a pre-filled syringe, the range of travel of the ram, or the end of travel of the ram. The assertion of this "belief" and "opinion" by the Board is a new issue requiring response.

Applicant's observation is that the only drawing of Reilly that shows ribs 74, is Fig. 5, and that figure does not show the plunger. There is thus no support for asserting any rib 74 would have a position "proximate to the plunger" for any given plunger position.

¹ Applicant disagrees with an interpretation of "physical indicia", as readable upon mere volumetric gradations. However, that point, which was asserted by the Examiner, was decided in his favor and is not being argued here. This request for reconsideration deals only with the new issue raised by the Board, namely, the support for a reading of the '858 patent as having a volumetric gradation that relates to the amount of fluid in a prefilled syringe, or the end or range of travel of the ram used with a syringe.

Moreover, Fig. 5 of the '858 patent shows that the ribs 74 are not present for the entire length of the syringe - rather, approximately the rearward sixth of the length of the syringe has no ribs at all. There is thus no rib that seems to be in the fully-rearward position, which would correlate to the full travel of the ram or the end of travel of the ram.

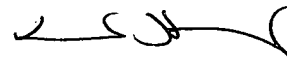
In fact, the rearward-most part of the syringe of Fig. 5, is the area where the plunger would be when the syringe is pre-filled. There is thus no rib 74 that would seem to correlate in location to the plunger when a syringe is pre-filled, as the Board's Decision believes to be the case.

The Board's reasoning upholding the rejection of claims 26, 28 and 30 is based solely on the disclosure of ribs 74 in the '858 patent, and the Board's "belief" and "opinion" that there is a rib 74 "proximate to the plunger" in a prefilled syringe, and a rib 74 that has a position related to the end and range of travel of the ram. Applicant submits, as stated above, that this is a new issue raised for the first time in the Board's opinion, and that the Board's position is not supported by the disclosure in the '858 patent. Applicant therefore submits that the decision

of the Board is in error, and asks that the Board reverse the Examiner's rejections of claim 26-31.

If any petition fee or fee for extension of time is necessary to accompany this communication, please consider this paper the appropriate petition, and apply the appropriate extension of time fee to Deposit Account 23-3000. If any other charges or credits are necessary to complete this communication, please apply them to Deposit Account 23-3000.

Respectfully submitted,



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